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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

EDWARDS, PATRICK L

ART UNIT PAPER NUMBER

2621

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/839,137	AKASHI, AKIRA	
	Examiner	Art Unit	
	Patrick L. Edwards	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-17 and 19-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-17, and 19-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 May 2005 has been entered.

Response to Arguments

2. Applicant's arguments filed on 14 February 2005 have been fully considered. A response to these arguments is provided below.

Prior Art Rejections

Summary of Argument:

A. Independent claims 1, 10, and 19 have been amended to change the previously recited "means for setting an image sensing mode" to the current "means for manually selecting one of a plurality of image sensing modes." Applicant alleges that Narayanaswami fails to disclose this limitation. Specifically applicant states that "The Office Action cites paragraph [0042] of this document to show this feature. But paragraph [0042] merely states ... that 'The user of the camera 100 can specify (via the user interface display 126) which of the plurality of parameters are to be watermarked into the the digital images (under the control of an applicable software program).'" (see remarks pg. 14).

B. Further, applicant alleges that "[T]he patent office has not yet satisfied its burden of proof to show that these claims are anticipated by the document to Narayanaswami et al."

C. Applicant repeats the above arguments, but addresses them with respect to independent claims 2, 11, and 20 and the Steinberg reference.

D. Applicant alleges that the combination of Narayanaswami et al. and Rhoads et al. does not disclose the concept of "determining, in accordance with the selected image sensing mode, whether to activate an embedding step or embedding means..."

Examiner's Response:

A. Applicant's arguments regarding paragraph [0042] are irrelevant because the previous office action did not attempt to show the feature of "means for manually selecting one of a plurality of image sensing modes." Indeed, this is a *newly added* limitation.

However, even if we assume, *arguendo*, that this argument is pertinent, it is still unpersuasive because the added limitations are disclosed by Narayanaswami. Applicant admits that Narayanaswami discloses a user interface display that the user uses to specify parameters (remarks, pg. 14). Is applicant suggesting that parameters input by a user are not selected manually? Such a suggestion would be contrary to the plain definition of the word

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“manually”, which is defined by Merriam-Webster as “Done by, used by, or operated with the hands.” Accordingly, the reference anticipates the claim limitation.

B. This argument is also moot. Let the record show that the claims have been amended to add new limitations. The examiner can not possibly apply art to future limitations and there is therefore no burden of proof for claim limitations that have not yet been presented.

C. See responses 1 and 2 above.

D. Applicant’s arguments have been fully considered but are unpersuasive. The limitation is disclosed in the previously cited combination. It is explained more clearly in the below rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3-6, 10, 12-15, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Narayanaswami et al. (US 2003/0011684 A1).

As applied to claim 1, Narayanaswami et al. disclose an image recording apparatus (see Fig. 1: Reference numeral 100 referring to a camera) including image sensing means for sensing an object (see paragraph [0032]: The reference describes a means for receiving and converting light energy from the photographic lens into suitable electric signals (i.e. image sensing means).) and means for embedding predetermined data in image data obtained by the image sensing (see Fig. 1: Reference numeral 134 referring to a watermark processor).

Narayanaswami further discloses means for manually selecting one of a plurality of image sensing modes (see Fig. 1 and paragraph [0042]-[0043]: Figure 1 shows a user interface means 126, and the cited paragraph describes “user-specified parameters” and even gives a table of these user-specified parameters at the end of paragraph [0043]. If a parameter is “user-specified” then it is “manually selected”).

Narayanaswami further discloses means for deciding an embedding mode for defining an embedding method for the embedding means in accordance with the manually selected image sensing mode (see Fig. 1 and paragraph [0042]: The reference describes a watermark processor 134 that embeds information in the image specified by the user. The user specifies what should be embedded using the user interface display 126.).

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Narayanaswami further discloses that the image sensing means senses an object on the basis of the manually selected image sensing mode (see paragraph [0034]: The reference describes that the camera senses an object based on the settings of the camera electronics.).

Narayanaswami further discloses that said embedding means executes the embedding of the predetermined data in the image data obtained by the image sensing means in accordance with the decided embedding mode (see paragraph [0042]: The reference describes that the watermark processor embeds information based on the parameters specified by the user.).

As applied to claim 3, Narayanaswami et al. disclose that the first item defines values associated with an exposure time and aperture of said apparatus (see paragraph [0034]: The reference describes that camera electronic circuitry 128 defines parameters including exposure duration (i.e. exposure time) and aperture setting (i.e. aperture of said apparatus).).

As applied to claim 4, Narayanaswami et al. disclose that the first item defines a value associated with a continuous-exposure frame count of said apparatus (see paragraph [0034]: The reference describes that camera electronic circuitry 128 defines parameters including frame number (i.e. a value associated with a continuous-exposure frame count of said apparatus).).

As applied to claim 5, Narayanaswami et al. disclose that the first item defines a value associated with image quality of a sensed image (see paragraph [0034]: The reference describes that camera electronic circuitry 128 defines parameters including image quality (e.g. high, medium, or low).).

As applied to claim 6, Narayanaswami et al. disclose that the first item defines a value associated with sensitivity with respect to an amount of light received (see paragraph [0034]: The reference describes that camera electronic circuitry 128 defines parameters including shutter speed, which determines the amount of light received. Therefore, this value is associated with sensitivity.).

As applied to claims 10, and 12-15, which merely call for the method performed by the apparatus of claims 1, 3-6, since Narayanaswami et al. disclose the apparatus for performing the method, then the method is also disclosed.

As applied to claim 19 which merely calls for a computer-readable memory storing code for executing the steps performed by the apparatus of claims 1 and 2, Narayanaswami et al. disclose such a computer-readable memory since a CPU 102 performs all of the processing in Narayanaswami et al.

5. Claims 2, 11, 20, 29, 32, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Steinberg (USPN 5,862,218).

With regard to claims 2, Steinberg discloses a means for manually selecting one of a plurality of embedding modes for defining an embedding method for the embedding means (Steinberg col. 5 lines 40-43 in conjunction with Fig. 3: The reference describes that the user creates (selects) a mark and corresponding indicium. Since the mark is what is embedded in the image, and the indicium is utilized in the process of marking, the user selection from the reference is a manual selection of an embedding mode.).

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Steinberg further discloses a means for deciding an image sensing mode for the image sensing in accordance with the manually selected embedding mode (Steinberg col. 5 lines 1-20; lines 38-67: The reference provides a detailed description of how the image acquisition process parameters (image sensing mode) is set on the basis of the mark to be placed on the image (the embedding mode)).

Steinberg further discloses that the image sensing means senses an object on the basis of the decided image sensing mode (Steinberg col. 5 lines 1-5).

Steinberg further discloses that the embedding means executes the embedding of the predetermined data in the image data obtained by the image sensing means in accordance with the embedding mode (Steinberg col. 6 lines 22-34).

As applied to claim 29, Steinberg further discloses manual selection of one of a plurality of embedding modes having different robustness from each other (Steinberg col. 7 lines 45-51: The reference describes that the indicium (which are selected manually, as is discussed above) are used to determine whether the watermarks are easy to remove or difficult to remove. This ease of removal is analogous to the "robustness" required by the claim.).

With regard to claims 11 and 32, since Steinberg discloses the apparatus for performing the method, the method is also disclosed.

With regard to claims 20 and 33, which adds a computer readable medium for storing a computer code for executing the steps of a method, Steinberg discloses a computer system.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7, 8, 16, 17, 21, 22, 24, 26, and 27-28, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Narayanaswami et al. (U.S. Patent Application Publication US 2003/0011684 A1) and Rhoads et al. (U.S. Patent Application Publication US 2002/0080997 A1). The arguments as to the relevance of Narayanaswami et al. in the rejection of claim 1 above are incorporated herein.

Claim 7 requires that the second item defines a type of watermarking and claim 8 requires that the second item defines a value associated with the embedding strength.

While Narayanaswami et al. does disclose that any conventional watermarking method may be employed by the system (see paragraph [0042]), the reference does not disclose that the second item defines the type of watermarking or the embedding strength.

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Rhoads et al., in the same field of endeavor of image processing and the same problem solving area of digital watermarking, discloses defining a type of watermarking and associating a value with the embedding strength (see paragraphs [0021]-[0023]: The reference describes that the user can select three different watermarking modes: low, medium, and high. The reference further describes that each of these watermarking modes embeds a watermark with a different durability.).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Narayanaswami et al. by allowing the system to define a type of watermarking and associate a value with the embedding strength as taught in Rhoads et al. because this allows the watermarking aspect of the system to become “highly automated and essentially transparent to a user” (see Rhoads et al.: paragraph [0017]). Therefore, the user merely needs to specify the type of watermarking and the strength of the watermarking and the system automatically watermarks the image without any further user interaction.

As applied to claims 16 and 17, which merely call for the method performed by the apparatus of claims 7 and 8, since the combination of Narayanaswami et al. and Rhoads et al. discloses the apparatus for performing the method, then the method is also disclosed.

As applied to claim 21, Narayanaswami et al. disclose an image recording apparatus (see Fig. 1: Reference numeral 100 referring to a camera) having image sensing means (see paragraph [0032]: The reference describes a means for receiving and converting light energy from the photographic lens into suitable electric signals (i.e. image sensing means).).

Narayanaswami further discloses selection means for selecting one of a plurality of image sensing modes (see paragraphs [0034] and [0039]).

Narayanaswami further discloses embedding means for embedding information as a watermark in an image (see Fig. 1: Reference numeral 134 referring to a watermark processor.).

Narayanaswami further discloses control means for—when said determination means determines that the information is to be embedded—performing control to activate said embedding means to embed the information in the image data sensed by said image sensing means (see Fig. 1: Reference numeral 102 referring to a CPU that acts as a control means for the system.).

As applied to claim 22, Narayanaswami et al. disclose that the information includes information specifying a user name, image sensing date, and image recording apparatus (see paragraph [0043]: The reference presents a table listing the types of information that can be embedded into the image including date, photographer (i.e. user name), and image mode (i.e. image recording apparatus).).

Claims 21 and 26 further call for a determination means for determining—in accordance with the image sensing mode selected by said selection means—whether to activate the embedding means. While Narayanaswami et al. disclose that the user can select which parameters are to be watermarked in the image (see paragraph [0042]), the reference does not describe the use of a determination means for determining whether or not to embed the data.

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Rhoads et al., in the same field of endeavor of image processing and the same problem solving area of digital watermarking, discloses a user interface that allows the user to instruct the system (i.e. determine) whether or not to embed the data (see paragraph [0017]).

As applied to claim 24, Rhoads et al. disclose that the embedding means comprises first embedding means for embedding information with priority given to image quality of an image in which the information is to be embedded, and second embedding means for embedding information with priority given to robustness of the information to be embedded, and means for determining one of said first and second embedding means when information is to be embedded (see Fig. 2 and paragraph [0021]: The reference describes that three watermarking modes can be selected: low, medium, and high. If the low watermarking mode is selected priority is given to the quality of the image. If the high watermarking mode is selected priority is given to the durability (i.e. robustness) of an image.).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Narayanaswami et al. by adding the determination means taught in Rhoads et al. because this allows the watermarking aspect of the system to become "highly automated and essentially transparent to a user" (see Rhoads et al.: paragraph [0017]). Therefore, the system can determine what type of watermark to embed in the image and automatically watermark the image without any further user interaction.

As applied to claims 28, 30, and 31, Narayanaswami fails to expressly disclose that the embedding modes are different in robustness from each other. Rhoads, on the other hand, discloses manual user selection of embedding modes with different robustness (Rhoads paragraph [0021]: The reference describes three watermarking modes which are different in durability (i.e. robustness).). It would have been obvious to one reasonably skilled in the art at the time of the invention to add user selection of embedding robustness as taught by Rhoads to the system of Narayanaswami. Such a modification would have allowed for a more robust system in that the user could control the durability/fidelity of the watermark (Rhoads paragraph [0020]).

As applied to claim 27, which merely call for the method performed by the apparatus of claim 21, since the combination of Narayanaswami et al. and Rhoads et al. discloses the apparatus for performing the method, then the method is also disclosed.

8. Claims 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Narayanaswami et al. (U.S. Patent Application Publication US 2003/0011684 A1) and Rhoads et al. (U.S. Patent Application Publication US 2002/0080997 A1), as applied to claim 21 above, and further in combination with Isnardi et al. (U.S. Patent No. 6,037,984 A).

Claim 23, which is representative of claim 25, calls for selectively embedding either a visible watermark or an invisible watermark.

This feature is absent from the combination of Narayanaswami et al. and Rhoads et al.; although Narayanaswami et al. discloses that any conventional watermarking method may be employed (see paragraph [0042]). However, Isnardi et al., in the same field of endeavor of image processing and the same problem solving area of digital watermarking, discloses selectively embedding a visible or invisible watermark (see column 2, lines

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43-46: The reference describes that the magnitude of the watermark values and their placement in the DCT array can be adjusted to selectively produce a visible or invisible watermark.).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Narayanaswami et al. and Rhoads et al. by adding the ability to selectively embed either a visible watermark or an invisible watermark as taught by Isnardi et al. because such a process allows for the system to selectively watermark an image with the best type of watermark for a specific application.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick L Edwards whose telephone number is (571) 272-7390. The examiner can normally be reached on 8:30am - 5:00pm M-F.

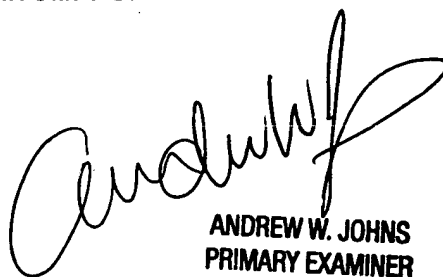
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Mancuso can be reached on (571) 272-7695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patrick L Edwards

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ANDREW W. JOHNS
PRIMARY EXAMINER